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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,034	04/18/2001	Donald J. Mischo	MISCHO-3	3538

20606 7590 02/24/2003

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EXAMINER

LECHERT JR, STEPHEN J

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/838,034

Applicant(s)

MISCHO, DONALD J.

Examiner

Stephen J. Lechert Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

1. The abstract of the disclosure is objected to because it is too long. Applicant is reminded that the abstract should be in a single paragraph and is a concise statement of what is being claimed in the application. The abstract should be between 50-150 words. Correction is required. See MPEP § 608.01(b).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takase et al.

Takase et al. disclose the invention substantially as claimed.

Takase et al. teach a method of making an asphalt paving composition by forming a mixture of asphalt flakes and a suitable dried aggregate. The admixture is

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then heated while being pressed onto a surface. [Note Column 1, lines 60-65 and note Claims 1-2]

However, Takase et al. does not specifically teach using recycled asphalt shingles as the flake material nor the specific step of shredding the asphalt shingles to provide the flake asphalt.

Takase et al. does teach providing asphalt flakes, which include materials such as flaky straight run asphalt, rubberized asphalt and blowing asphalt.[Note Column 1, lines 60-65] Applicant's claims are drafted with comprising language, to eliminate a step such as the shredding step to produce a flaky asphalt particle would have been obvious from reading Takase et al. and to use any source of asphalt such as scrap shingles to provide the asphalt flakes would be obvious to one of ordinary skill in the art where asphalt flakes has been broadly taught. Takase et al. further teaches that there is heating and pressing step and to add a step of pressing while heating is also permissible with the open "comprising" language because the addition of a step plus function is obvious to one having ordinary skill in the art, the combined heating and pressing provides the embedded asphalt flakes. Takase et al. specifically teaches using a flaked form of asphalt which is then admixed with an aggregate such as sand and subsequently heated and pressed into a surface which broadly reads on applicant's steps of embedding the surface treatment material into the surface of the asphalt flakes. The heating and pressing step taught in Takase et al. is functionally equivalent to embedding sand onto the asphalt flakes thus rendering the invention as a whole obvious to one having ordinary skill in the art at the time of the invention was made.

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5. Claims 2-4 are rejected as being dependent upon a rejected base claim.
6. Claims 2-4 would be allowable in independent form including the subject matter of the base claim because the prior art fails to teach or suggest using an additional additive of a surfactant and drying step.
7. Claims 5-10 are free of the prior art.
8. The following is a statement of reasons for the indication of allowable subject matter: The method and apparatus for producing a ground cover from used or scrap asphalt material comprising mixing asphalt flake material with dry and liquid surface treatment material in a mixing chamber having inlet and outlet means for introducing the scrap material, the surface treating materials in both dry and liquid forms, followed by heating the mixture in the mixing chamber sufficiently to embed the surface treating material into the asphalt flakes and thereafter discharging the surface treated asphalt material from the chamber has not been taught either singularly or in combination by the prior art.
9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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10. Claim 11 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of copending Application No. 09/837,920. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. Claim 11 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of copending Application No. 09/838,034. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Niwa et al. teach mixing asphalt material with raw fibrous material, molding and heating the mixture to produce fibrous plates impregnated with asphalt.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 703-305-6156. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



Stephen J. Lechert Jr.
Primary Examiner
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February 19, 2003